REMARKS

This paper is filed in response to the Office Action mailed October 3, 2003 that made restriction and election of species requirements. Applicants were requested to elect one of nine designated groups. Applicants were also required to elect numerous species.

Accompany this response, Applicants have also amended the claims as follows:

Claim 10 is amended to become an independent claim.

Claim 21 is added. Claim 21 is supported by, e.g., original claim 15.

Claims 12, 13, 14, 16 and 20 are canceled.

In response to these requirements, Applicants hereby elect **with traverse** the invention of Group 1. Applicants also elect the following species for "generic" claims 1, 15 and 17:

1. Secreted compounds: Enzyme
2. Organism: Fungal and Bacterial
3. Antibodies: Polyclonal

Applicants further elect the following species, as requested by the Office:

A. Claim 2: Enzyme

B. Claim 3: An Enzyme Assay

C. Claim 6 (a particular enzyme): A carbohydrase

D. Claim 6 (a particular functional assay): Assay for thermal stability

E. Claim 7: fungal and bacterial

F. Claim 8: An enzyme assay

G. Claim 9: thermal stability

H. Claim 10: Genomic

I. Claim 12: An enzyme

J. Claim 13: An enzyme

K. Claim 14: A carbohydrase

L. Claim 18 (a screened microorganism, a genus): Aspergillus

M. Claim 18 (a screened microorganism, ultimate species): *A. oryzae*

N. Claim 19: soil sample

Applicants hereby reserve the right to file continuing applications directed to the nonelected subject matter.

The election is with traverse. In particular, Applicants respectfully submit that at least Group I, Group II, Group III and Group V are improperly subject to a restriction requirement. The basis for traverse is discussed below.

1. Group I, Group II, Claim 11 of Group III and Group V Should be Examined Together

The Office alleges that Group I (Claims 1-7), Group II (Claims 1, 8 and 9), claim 1 of Group III and Group V are alleged to be classified in separate classifications, namely, Class 435, subclass 4 for Group I, Class 436, subclass 63 for Group II, Class 436, subclass 41 for claim 11 of Group II and Class 702, subclass 20 for Group V.

Foremost, with respect to the method claims, the Office gives no specific factual basis or justification for the restriction requirement imposed on the Applicant for the method claims, as is required under MPEP 808. Instead, the Office recites various general conclusions lacking factual support, stating that the claimed methods constitute patentably distinct inventions because Groups I-III, V, VII, and VIII are directed to methods that recite structurally and functionally distinct elements, are not required for one another, and achieve different goals. The Office also generally concludes, without factual support, that the inventions are distinct because (a) they have acquired separate status in the art as shown by their different classifications; (b) had different and separately burdensome manual and/or computer structure, name and bibliographic searches; and (c) have divergent subject matter.

Applicants respectfully submit that at least Group I, Group II, claim 11 of Group III and Group V should not be subject to a restriction requirement and should be examined together as the requirements for restriction have not been met by the Office.

a. Groups I and II

First, the Office's conclusions that Groups I and II recite structurally and functionally distinct elements that are not required for one another and achieve different goals is clearly not valid. Both Groups I and II are based on the invention defined by claim 1. Clarification of the factual basis for this conclusion is requested if the restriction requirement is maintained.

The Office's conclusion that Groups I and II have acquired separate status in the art as shown by their different classifications also cannot be correct. Groups I and II are both based on claim 1. Applicants can find no factual basis for how claim 1, which is central to both Group I and Group II, can simultaneously be classified in entirely separate classifications and obtain a separate status in the art. If the Office maintains the restriction requirement for Groups I and II, the Office is requested to clarify how claim 1 can simultaneously obtain a separate status in the art, and how the Groups I and II, which both depend on the claim 1, are separately classified.

Claims 8 and 9 depend from claim 1. Claims 8 further recites that the method involves subjecting a secreted compound from a positive clone to an assay in which a desired functionality is tested to identify clones that produce a compound exhibiting the desired functionality. Claim 9 further recites various preferred functionalities of claim 8. A restriction requirement is not proper simply because a claim adds an additional limitation to the claim from which it depends. Indeed, Applicants are clearly entitled to present and have considered in one examination process additional claims which further limit the main claim. This is the very essence of what a dependent claim is.

The Office's further general conclusion that Groups I and II have different and separately burdensome manual and/or computer structure, name and bibliographic searches is also clearly not correct. Again, both Groups I and II are based on claim 1. Certainly, the same art would be involved and reviewed in the Office's search and patentability evaluation. If the Office maintains the restriction between Groups I and II, the Office is requested to explain how Groups I and II have different and separately burdensome manual and/or computer structure, name and bibliographic searches.

The conclusion that Groups I and II are based on divergent subject matter is also not correct. Again, both groups are based on the invention recited in claim 1. Groups I and II clearly cannot be based on divergent subject matter given that they are both based on the same claim. If the Office maintains this restriction, the Office is requested to provide more information as to how Groups I and II form divergent subject matter.

b. Group I and Claim 11 from Group III

The above statements are also true for claim 11 of Group III (Group III is discussed below), as claim 11 depends from claim 1 and includes all of the limitations of claim 1. In particular, claim 11 further defines the invention of Group I by reciting that the preparation of the gene library includes the additional step of mutating a nucleotide sequence in the library. The Office has included claim 11 with claim 10 of Group III. Applicants do not see why claim 11 is classified with claim 10 instead of claim 1. If the Office maintains this restriction, the Office is requested to clarify the reasoning for this conclusion.

c. Group I and Group V

Group V, which consists of only claim 15, is also not properly restricted from Group I. Claim 15 and claim 1 include identical steps (a)-(e). Claim 15 differs from claim 1 in the preamble recitation and in the fact that it includes the additional step of nucleotide sequencing to identity at least one nucleotide sequence encoding a secreted compound.

The general conclusion provided in the written restriction requirement do not justify restriction of Groups I and V. The Office's conclusion that Groups I and II have acquired separate status in the art as shown by their different classifications also cannot be correct as Groups I and II include identical steps (a)-(e).

The Office's further general conclusion that Groups I and V have different and separately burdensome manual and/or computer structure, name and bibliographic searches is also clearly not correct. The Office is requested to explain how Groups I and V have different and separately burdensome manual and/or computer structure, name and bibliographic searches.

The conclusion that Groups I and II are based on divergent subject matter is also not correct. Again, both groups include identical process steps (a)-(e). If the Office maintains this restriction, the Office is requested to provide more information as to how Groups I and II form divergent subject matter.

Thus, Groups I and V are highly related (containing identical steps (a)-(e)) and would involve a search of the same art. If the Office maintains the restriction of Groups I and V, the Office is requested to provide a factual basis for why these inventions are distinct so as to create an undue burden and justify restriction because no factual basis as been provided.

Applicants, therefore, respectfully submit that the restriction requirement as to Groups I and V is also clearly improper and not factually supported.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction requirement, as Group I, Group II, claim 11 of Group III and Group V.

2. Group I and Group III Should be Examined Together

Groups I and III are also not properly subject to a restriction requirement. Group III, claim 10, provides an alternative method of carrying out the process recited in Group I, namely, by providing a gene library from one or more microorganisms different from the donor organism. Group III, claim 11, provides an additional step of mutating a nucleotide sequence in the library. Groups I and III are identified by the Office as being in slightly different subclasses (subclass 4 vs. subclass 41).

Claim 11 is submitted to not properly be subject to a restriction requirement with Group I for the reasons discussed above. If the restriction is maintained, Applicants request that the Office clarify the basis for the restriction as the current written restriction requirement provides no discernable facts which would justify imposition of the restriction between Group I and claim 11.

With respect to claim 10, although it is dependent on claim 1, it is not necessarily further limiting as it instead provides an alternative method for carrying out step b of the invention. Claim 10 has been amended to recite an independent claim. Nevertheless, claim 10 is also

highly related to claim 1, including many common steps, such that it is not an undue burden on the Office to include claim 10 within the search.

Applicants, therefore, respectfully submit that the restriction requirement for Group I and Group III is also improper. Applicants respectfully request reconsideration and withdrawal of the restriction requirement, as applied to Groups I and III.

The Office is hereby invited to contact the undersigned by telephone if there are any questions concerning this response or application.

Respectfully submitted,

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